

REMARKS

This amendment responds to the final office action mailed September 10, 2008. In the office action the Examiner:

- objected to the specification, and in particular to failing to provide proper antecedent basis for the claimed subject matter; and
- rejected claims 15-22 and 32-37 under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (U.S. 2005/0144157, hereinafter “Moody”).

After entry of this amendment, the pending claims include: claims 15-22 and 32-37.

Office Actions in Related Applications

The pending application is related to US Patent Application serial number 10/816,428. An office action on that application was mailed June 26, 2008 and a response was filed October 27, 2008. The pending application is also related to US Patent Application serial number 10/914,034. An office action on that application was mailed April 22, 2008 and a response was filed July 22, 2008. The Examiner is encouraged to review the art made of record, the Office Action and the response in the above-mentioned related applications.

CHANGES TO CLAIMS

Claims 15, 20, 32, and 37 have been amended to more clearly define the subject matter being claimed. Support for this change is found at least in ¶¶ 0098-0101 and 0106-0108 in the application as filed. No new matter has been added.

OBJECTIONS TO SPECIFICATION

In the response filed on April 22, 2008, changes were made to paragraph 0143, which Applicant believes addresses the objection to the specification made in the Office Action. As revised, paragraph 0143 provides support for the term “computer readable storage medium.”

The Examiner is respectfully requested to acknowledge the previously filed changes to the specification. No new matter has been added.

REJECTION UNDER 35 U.S.C. 103(a)

Claims 15-22 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP §2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A. Moody’s Threads of Messages Do Not Meet Predefined Criteria For a Conversation

Claim 15 is directed to “identifying a plurality of conversations” relevant to a search query. Moody does not teach:

...identifying a plurality of conversations relevant to the search query, the plurality of conversations including at least two conversations each having two or more messages sharing a common set of characteristics that meet predefined criteria and a respective conversation identifier, wherein the predefined criteria includes a subject of the two or more messages and information other than the subject, a reply-to field, a references field and a message identifier field of the two or more messages; and
returning to the client a list of the identified conversations as a search result to the search query.
(Claim 15, emphasis added)

Moody specifically does not teach conversations comprised of messages “sharing a common set of characteristics that meet predefined criteria,” where the predefined criteria includes “a subject of the one or more messages and information other than the subject, a references field, a reply-to field, and a message identifier field of the two or more messages.” Applicants respectfully request the Examiner to consider all words in the amended claim limitations and to give the claim limitations the broadest reasonable interpretation consistent with the specification. See MPEP § 2111 and § 2143.03. Although Moody identifies individual messages relevant to a search query, it does not identify conversations relevant to a search query, where conversations are as defined in the revised claims.

Applicant disagrees with the Examiner’s assertion that Moody’s threads are equivalent to “conversations” (see Office Action, p. 4 and Advisory Action dated 11/19/2008), and has amended the claims to clarify the distinction. Amended claim 15, by its terms, specifically defines a conversation to have messages that meet predefined criteria which includes “information other than the subject, reply-to field, a references field and a message identifier field.” Moody, on the other hand, does not specifically define a thread of

messages, except to say that the messages in a thread are determined by a threading service (110).

B. The Terms “Conversation” and “Messages” Are Not Interchangeable

In evaluating the pending claims, it is important to note that the definition of a “message” is distinct from that of a “conversation.” The “plurality of conversations” in claim 15 include “at least two conversations each having two or more messages sharing a common set of characteristics.” The Examiner’s remarks concerning “threads” would appear to be in agreement with the proposition that messages and threads are distinct logical entities, and thus it would appear that the Examiner also agrees that messages and conversations are distinct logical entities.

C. Moody Does Not Return a List of Conversations

As a preliminary matter, it is noted that the pending claims do not recite “at least one conversation.” Instead, the pending claims consistently recite “a plurality of conversations”. Thus, the undersigned attorney is unsure why the office action, in paragraph 6, refers to “identifying at least one conversation.”

Claim 15 requires “returning to the client a list of the identified conversations as a search result to the search query.” Moody, on the other hand, produces a list of messages (which the Office Action refers to as “at least one conversation”) relevant to a query. See [0053]-[0060] for various examples of list of messages produced by Moody.

As discussed in more detail below, Moody does not teach “returning to the client a list of the identified conversations as a search result to the search query” and therefore fails to teach at least one element of Claim 15. Moody only teaches displaying a single list of messages at one time, irrespective of the number of threads to which those messages belong, and does not provide any teachings for organizing those messages into a list of conversations.

Applicant agrees with the Examiner that Moody teaches (see [0059] and [0060]) that the user in Moody can select a message from a first list of messages (e.g., messages that meet a search query), and then obtain a second list of the messages in the same thread as the user-selected message. To “see” all the threads having at least one message that meets a search query, the user in Moody would need to select individual message after individual message in the first list of messages, and then one-by-one view the threads corresponding to each of those messages. However, it is noted that this rather painful way of seeing all the threads having at least one message meeting a search query is dramatically different from receiving

(or producing) a list of conversations in response to a search query. Furthermore, even the expand/collapse mechanism taught by Moody in [0059] and [0060] does not produce a list of conversations when the “collapse” mechanism is used, because the collapsed list of messages is still a list of messages.

In fact, Moody consistently produces different results from the claimed invention. This can be shown by a couple of simple examples. For exposition purposes only, the differences between threads and conversations will be ignored in these examples. In a first example, there are six messages that match a query, and the six messages are in three threads, Moody returns a list of six messages (using the “Search Only for Messages that Include Search Terms” option) (See Moody [0056]), whereas the claimed invention returns a list of three conversations.

In a second example, there are six messages that match a query, and the six messages are in three threads that contain a total of 100 distinct messages. Using Moody’s “Search for Messages that Include Search Terms and All Related Messages” option, Moody returns a list of 100 messages in response to the query (see Moody [0057]), whereas the claimed invention returns a list of three conversations. A list of 100 items (all of which identify messages) is certainly very different from a list of 3 items (all of which identify conversations).

Another example may be helpful in illustrating the distinction between the operation of Moody and the claimed invention. In this example, conversations are analogous to books, and the messages contained in the conversations are analogous to the words in the books. Using the claimed invention, the list of conversations obtained in response to a query is like a list of books. In contrast, the list obtained in Moody, when using the “search for ... all related messages” option, provides the user with a list of all the words in the all the books that meet a search query. Receiving a list of all the words in the books that meet the search query is very different from receiving a list of the books. In the same way, the “list of conversations” produced by the claimed invention is distinct from the list of messages produced by Moody.

For at least the reasons explained above, the statement in the Office Action (page 4) that:

However, it is clear from the disclosure of Moody that the system will return a list of all conversations satisfying the search criteria..., [w]hile Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody’s disclosure to at least suggest such an embodiment...”

is a conclusion, unsupported by evidence and articulated reasoning. It is also noted that this statement in the office action significantly misstates what is being claimed, as this statement fails to make any mention of the “list of the identified conversations” that is returned.

It is also noted that Figure 2 of Moody discloses a single list of messages 224, Figures 3 and 4 of Moody relate to managing messages in a single thread, and Figure 5 shows a query box 562 for searching for messages related to particular search terms. As discussed above, search results in Moody are consistently displayed as a single list of messages. The Moody specification does not provide for any search result that includes “a list of the identified conversations.” Therefore, claim 15 is patentably distinct from the teachings of Moody.

All of the pending claims are patentable over Moody for at least the same reasons as those explained above with reference to Figure 15.

D. Concluding Remarks

As stated in the 2007 *KSR* decision: “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). Examiners must avoid the “temptation to read into the prior art the teachings of the invention in issue” and must “guard against slipping into the use of hindsight.” *KSR* citing *Graham*, 383 U.S., at 36. It is respectfully submitted that the Office Action fails to provide any reasons that “[w]hile Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody’s disclosure to at least suggest such an embodiment,” as evidenced by the fact that no reference was made to particular facts or portions of the Moody reference that show an apparent reason that Moody suggests producing a list of conversations as a search result.

The pending claims should be allowed because the cited reference does not teach conversations as defined by the revised claims, and because the cited reference also does not teach or suggest in any way “returning...a list of the identified conversations” and therefore claim 15 and its dependent claims are patentable over Moody. Amended claims 20, 32 and 37, and their dependent claims are patentable over the cited reference for at least the reasons discussed with reference to claim 15.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner

is invited to call the undersigned attorney at (650) 843-4000, if a telephone call could help resolve any remaining items.

Respectfully submitted,

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